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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/932,621  | 08/17/2001  | Yuichiro Deguchi     | SONY-02800              | 6301             |
| 7590  | 06/02/2005  |                      | EXAMINER                |                  |
| Valley Oak Law<br>5665 Silver Creek Valley Rd. #106<br>San Jose, CA 95138 |             |                      | HASHEM, LISA            |                  |
|   |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 2645                    |                  |
|   |             |                      | DATE MAILED: 06/02/2005 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                   |
|------------------------------|-----------------|-------------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)      |
|                              | 09/932,621      | DEGUCHI, YUICHIRO |
|                              | Examiner        | Art Unit          |
|                              | Lisa Hashem     | 2645              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 17 November 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-43 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-43 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 17 November 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**FINAL DETAILED ACTION**

1. The affidavit under 37 CFR 1.131 filed November 17, 2004 is ineffective to overcome the rejection of: claim(s) 1-43 based upon the 35 U.S.C. 103(a) rejection under Tree in view of Deguchi, as set forth in the last Office action because: the affidavit is not signed by a party qualified under MPEP § 1.42, § 1.43, or § 1.47 and it is the incorrect document to show that the present application, Tree, and Deguchi are commonly owned. See MPEP § 1.130 and § 1.131.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,650,534 by Tree in further U.S. Patent Application Publication No. US 2002/0007354 by Deguchi.

4. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Tree discloses a data marker integrated device communication system (see Figure 2), comprising: a data marker integrated device (Figure 2, 200) configured to store one or more data marks (column 1, lines 17-31); a network device or gateway device, such as a mobile telephone with wireless internet access configured to inherently establish wireless communication with the data marker integrated device to receive said one or more data marks from said data marker integrated device (column 5, lines 13-20; column 5, lines 36-49).

Tree does not disclose a server terminal configured to connect to said network device for data communication.

Deguchi discloses a data marker integrated device communication system (see Figure 1), comprising: a data marker integrated device (Figure 1, 101) configured to store one or more data marks (page 3, section 0028, lines 1-17); a user terminal (Figure 1, 103) configured to inherently establish wired communication with the data marker integrated device to receive said one or more data marks from said data marker integrated device (page 3, section 0036, lines 1-20); and a server terminal (Figure 1, 105) configured to connect to said user terminal for data communication (page 3, section 0032, lines 1-15; page 3, section 0036, lines 6-15).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Tree to include a server terminal as taught by Deguchi to

include a server terminal configured to connect to said network device for data communication.

One of ordinary skill in the art would have been lead to make such a modification since the system can comprise a server terminal that is configured to receive said one or more data marks from said network device.

Regarding claim 2, the system of claim 1, wherein Deguchi further discloses each of said one or more data marks includes a time stamp information (page 1, section 0006, lines 1-4; page 4, section 0038, lines 6-10).

Regarding claim 3, the system of claim 1, wherein Deguchi further discloses said data marker integrated device includes one of an electronic music marker integrated radio and an electronic music marker integrated audio playback device (page 2, section 0023, lines 1-14).

Regarding claim 4, the system of claim 1, wherein Tree further discloses said network device includes one of a wireless application protocol (WAP) enabled mobile telephone, an i-mode mobile telephone, and an Internet access enabled personal digital assistant (column 5, lines 42-49).

Regarding claim 5, the system of claim 1, wherein Tree further discloses said wireless communication between said network device and said data marker integrated device is established with Bluetooth communication protocol (column 5, lines 42-49).

Regarding claim 6, the system of claim 1, wherein Tree further discloses said data marker integrated device includes an interface unit configured to establish wireless communication under Bluetooth communication protocol (column 5, lines 36-49).

Regarding claim 7, the system of claim 6, wherein Tree further discloses said network device includes an interface unit configured to inherently establish wireless communication under Bluetooth communication protocol (column 5, lines 36-49).

Regarding claim 8, the system of claim 7, wherein Tree further discloses said Bluetooth communication protocol operates at approximately 2.4 GHz, which is the known frequency at which Bluetooth operates in some countries to one of ordinary skill in the art (column 5, lines 36-49).

Regarding claim 9, the system of claim 1, wherein Deguchi further discloses said data marker integrated device is configured to transmit device identification code to said network device (page 2, section 0019, lines 11-16).

Regarding claim 10, please see the rejection to the system of claim 1 to reject the system of claim 10.

Regarding claim 11, the system of claim 10, wherein Deguchi further discloses said server terminal is further configured to inherently transmit a transmission acknowledgement message to said network device (page 4, section 0041, lines 4-8).

Regarding claim 12, the system of claim 11, wherein Deguchi further discloses said network device is configured to display said transmission acknowledgement message (page 4, section 0044, lines 10-14).

Regarding claim 13, the system of claim 11, wherein said network device is configured to inherently transmit said transmission acknowledgement message to said data marker integrated device (page 4, section 0044, lines 1-14).

Regarding claim 14, the system of claim 13, wherein said data marker integrated device is configured to delete said stored one or more data marks via the user terminal after inherently receiving said transmission acknowledgement message from said network device (page 4, section 0044, lines 6-10).

Regarding claim 15, the system of claim 1, wherein Deguchi further discloses a user terminal configured to connect to said server terminal (see Figure 1; page 2, section 0020, lines 1-3).

Regarding claim 16, the system of claim 15, wherein Deguchi further discloses said user terminal inherently includes one of a desktop computer, a laptop computer, and a handheld computer (pages 1-2, section 0019, lines 1-19; page 3, section 0032, lines 1-15).

Regarding claim 17, the system of claim 15, wherein Deguchi further discloses said user terminal is connected to said server terminal via TCP/IP protocol (pages 1-2, section 0019, lines 1-9; page 3, section 0032, lines 1-15).

Regarding claim 18, the system of claim 15, wherein Deguchi further discloses said user terminal is configured to receive information corresponding to said one or more data marks from said server terminal (page 3, section 0036, lines 6-15).

Regarding claim 19, the system of claim 18, wherein Tree further discloses said information corresponding to said one or more data marks includes one or more of a name of a broadcast music clip corresponding to said one or more data marks, a name of the artist of a broadcast music clip corresponding to said one or more data marks, a name of the album of a broadcast music clip corresponding to said one or more data marks, and a purchase information

for a music album corresponding to a broadcast music clip related to said one or more data marks (column 1, lines 17-31).

Regarding claims 20, 21, 22, 25, 26, and 30, please see the rejections to the system in claims 1, 5, 9, 11, 12, and 19 mentioned above, respectively, to reject the method in claims 20, 21, 22, 25, 26, and 30.

Regarding claim 23, the method of claim 22, wherein Deguchi further discloses transmitting said device identification code using said established connection to said server terminal (page 2, section 0019, lines 11-16).

Regarding claim 24, the method of claim 20, wherein Tree further discloses said connection inherently includes a wireless application protocol connection (column 1, section 12-16; column 4, section 0043, lines 3-11).

Regarding claim 27, the method of claim 25, wherein Deguchi further discloses deleting said one or more data marks after receiving said transmission acknowledgement message (pages 3-4, section 0037, lines 1-5).

Regarding claims 28 and 29, please see the rejections to the system in claim 18 mentioned above, to reject the method in claims 28 and 9.

Regarding claim 31, please see the rejections to the system in claims 1 and 7, mentioned above, to reject the method in claim 31.

Regarding claims 32-39, and 41, please see the rejections to the method in claims 22-24, 23, 26-30, mentioned above, respectively, to reject the method in claims 32-39, and 41.

Regarding claim 40, the method of claim 38, wherein Deguchi further discloses displaying said retrieved information (page 3, section 0036, lines 15-20).

Regarding claim 42, please see the rejections to the system in claims 1 and 10, mentioned above, to reject the system in claim 42.

Regarding claim 43, please see the rejections to the system in claims 1 and 7, mentioned above, to reject the system in claim 43.

***Response to Arguments***

5. Applicant's arguments filed 11-17-2004 have been fully considered but they are not persuasive.

6. Accordingly, this action is **FINAL**.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,819,267 by Edmark et al disclose a system and method for activating bookmark files on a computing device; the computing device selects appropriate bookmarks for the user's location based on GPS
- U.S. Patent No. 6,766,363 by Rothschild discloses a system and method for enabling a user with a mobile device to link to information, on a local or global electronic network, related to an item of interest to the user while observing a visual, audio, or printed medium containing the item

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE  
PATENT EXAMINER**

*Ovidio Escalante*

*LH*  
May 27, 2005